

Serial No. 10/084,381
Amendment After Final dated December 9, 2004
In Reply to Office Action dated September 9, 2004

R E M A R K S

The Office Action dated September 9, 2004 has been received and its contents carefully noted.

In view of the foregoing amendments, and following representations, reconsideration and allowance are respectfully requested.

Examiner Musser is thanked for the courtesies extended undersigned counsel during the telephone discussion of September 16, 2004. During that discussion, Examiner Musser indicated that a Request for Continued Examination (RCE) was appropriate to ensure that arguments related to Applicant's unexpected results and Applicant's asserted nonobviousness of the use of nitrile butadiene rubber that eliminated the need for damaging separating means (separating agents) be presented.

Applicant has done so by the filing of this RCE and requests reconsideration and allowance of the application. As to the September 9, 2004 Office Action in detail, please note the following.

To overcome the rejection of claims 7 and 8 under 35 U.S.C. 112, second paragraph, Applicant has added the inadvertently missing step, as recognized by the Examiner. Examiner Musser had

Serial No. 10/084,381

Amendment After Final dated December 9, 2004

In Reply to Office Action dated September 9, 2004

correctly assumed that the present step e) had been inadvertently left out of claim 7, as stated by the Examiner, and she had correctly indicated that "for the purposes of examination, it is assume that this step is part of claim 7."

The addition of amended paragraph e) provides strict antecedent basis for "the embossing copy" in present claim 8.

Thus, both claim 7 and 8 are definite.

The spelling of --nitrile butadiene rubber ((NbR))-- has been amended to be consistent with the spelling, as filed.

To overcome the rejection of claims 7 and 8 as being unpatentable under 35 U.S.C. 103 over German patent no. 43 24 970 A1 to Minke et al., modified by U.S. Patent No. 5,397,417, to Goto et al., and still further modified in view of British patent no. 1 063 154 to Hallam et al., Applicant has amended independent claim 7 to still further define thereover.

Assuming, for the sake of argument, that a person having ordinary skill in the art would have combined the teachings of those three(3) references together, absent any clear motivation therefor, then Applicant's claimed invention still would not have resulted.

Serial No. 10/084,381

Amendment After Final dated December 9, 2004

In Reply to Office Action dated September 9, 2004

First, the Examiner's arguments to the contrary, Goto's teaching of cutting plastic material (i.e. a sheet of nitrile butadiene rubber using a laser) is unrelated to the claimed invention. The claimed invention has set forth the novel and unobvious method of providing a method of producing an embossing roller having the claimed "material in the region of the circumferential surface of the auxiliary roller being nitrile butadiene rubber (NbR)". Applicant has invented a method and determined that nitrile butadiene rubber has the previously unrecognized benefit that nitrile butadiene rubber is the preferred material in the region of the circumferential surface of the auxiliary roller. This has been set forth in detail in Applicant's application as filed, such as on page 5, lines 14- page 6, line 2.

Applicant has determined that the use of nitrile butadiene rubber has the unobvious benefit, which had not previously been recognized in the prior art at the time of the invention, that the nitrile butadiene rubber in the region of the circumferential surface of the auxiliary roller provides for the removal of the embossing copy without damage to the fine structure of the embossing surface.

Serial No. 10/084,381

Amendment After Final dated December 9, 2004

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Applicant's claimed invention has thus made unnecessary the use of a separating agent, such as a chemical separating agent (i.e. a chemical separating agent which would otherwise have been used by a person having ordinary skill in the art at the time the invention was made) and which separating agent can damage the fine structure of the embossing surface, as set forth in Applicant's specification referenced above.

On reviewing the application, Applicant noted that the German term "Trennmittel" had been translated as "separating means" as set forth on page 5, line 18 of the application, as filed.

However, in this art, one could have even more particularly translated the term "Trennmittel" as "separating agents" emphasizing that such were known chemical separating agents. Such known chemical separating agents have the drawback of damaging define structure of the embossing surface as set forth in the amended paragraph on page 5, lines 14-19, and in that paragraph, as filed.

In support of this, Applicant has submitted in the attached Appendix three(3) dictionary citations; i.e. 1) a standard German-English Dictionary volume; 2) a standard English-

Serial No. 10/084,381

Amendment After Final dated December 9, 2004

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German/German- English "Dictionary of Plastics and Rubber Technology German/English, and 3) a copy of a web page from <http://dict.leo.org> providing English-German translations to support the correctness of this more precise translation of "Trennmittel".

Applicant request that the Patent Examiner confirm that she has considered each of the three(3) dictionary citations in response to the Office Action.

Claim 8, which sets forth additional novel features of Applicant's invention, will be allowed to rest on its dependence from independent claim 7 at this time.

None of the three(3) references applied by the Examiner had recognized, addressed, nor inherently solved the problem of prior art materials which required the use of a separating agent. That prior art use of a separating agent was a previously unsolved problem, as the use of such separating agents were damaging to the fine structure of the embossing surface, unlike Applicant's claimed invention, which requires no separating agent, thanks to its novel and unobvious combination of steps and materials including nitrile butadiene rubber in the region of the circumferential surface of the auxiliary roller.

Serial No. 10/084,381
Amendment After Final dated December 9, 2004
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In sum the application is submitted to be in condition for allowance with claim 7 and 8.

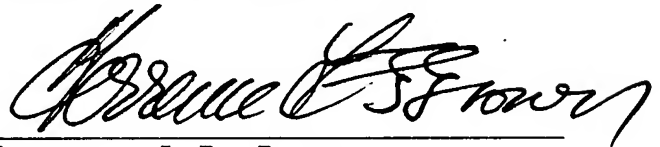
Claim 7 is in independent form.

Attached is a check in the amount of \$395.00. It is believed that no additional fee is due for this submission. Should that determination be incorrect, however, the Examiner is hereby authorized to charge any deficiencies to our Deposit Account No. 19-2105, and notify the undersigned in due course.

Should any outstanding formal matters or other issues remain, please telephone Terrence Brown to resolve such.

Respectfully submitted,

Date: December 9, 2004


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Serial No. 10/084,381
Amendment After Final dated December 9, 2004
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APPENDIX

CONTENTS:

1. Worterbuch Der Industriellen Technik, Band II, English-Deutsch, Funfte, vollllkommen uberarbeitete und erheblich erweiterte Auflage, published by Oscar Brandstetter Verlag, Wiesbaden Germany (front page and page 1100 ("separate") 2/pages);
2. Dictionary of Plastics and Rubber Technology German/English/ Worterbuch Kunststoff-und Kautschuktechnologie Deutsch/English, M.S. Welling, publisher Weinheim - New York(front page and page 265 ("Tragwerk-Trennungsprozess/2 pages); and
3. Leo internet citation for agent for "separating agent [tech.]", website <http://dict.leo.org>, downloaded 20 October 2004(search term "Trennmittel" and search term "separating agent")/2 pages).